

REMARKS

Claims 43-78 are pending in the present application. Claims 43 and 75 are currently amended.

Rejections under 35 U.S.C. §112

Claim 75 is rejected under 35 U.S.C. §112.

The Examiner contends that claim 75 is invalid as it uses the phrase “stored value instrument” which is unsupported by the description. The applicant submits that “stored value instrument” is merely in reference to an instrument which is able to store a particular monetary value onboard on its electronic memory. While this phrase was not directly used in the specification, a person skilled in the art, when considering a goods or services voucher in an e-commerce context as is described in the present application, the person skilled in the art is likely to consider that a stored value instrument is well-within the scope of what is defined to be a goods or services voucher. Accordingly, it is submitted to the Examiner that this phrase is clearly supported by the description as the concept of a goods and services voucher and its usage within an e-commerce environment is very clearly described throughout the entire specification.

Rejections under 35 U.S.C. §103

Claims 43, 74 and 75 are rejected under 35 U.S.C. 103 as being unpatentable over Walker et al. (US Patent No. 6,193,155) in view of Druckenmiller et al. (U.S. Patent No. 6167435).

The Examiner at paragraph 3 of the report contends that claims 43, 74 and 75 are obvious to a person skilled in the art when combining Walker et al. (US Patent No. 6,193,155) and Druckenmiller et al (U.S. Patent 6,167,435).

The applicant respectfully disagrees with the Examiner's contention that a person skilled in the art is likely to combine the two documents and further submits that even in the unreasonable event that the person skilled in the art was to combine the two documents the combination would not direct a person skilled in the art to the presently claimed invention.

Walker teaches a method and apparatus for issuing and managing gift certificates. The system that is disclosed by this document operates by allowing a credit card issuer to produce a gift certificate associated with the credit card account. In the previous Office Action, the Examiner conceded that Walker does not disclose the feature of generating a random, non-sequential alphanumeric token which is used to validate the voucher. Rather, the gift certificate disclosed by Walker is associated with a credit card account (at column 5, line 17 to line 23 it is very clearly stated that a sixteen digit numeric value is generated and associated with the gift certificate, and that this value is directly relevant to the account holder's credit card account). It is also stated at line 19 that the sixteen digit number that is used to identify the gift certificate can be a previously unused credit card number. It is submitted to the Examiner that in accordance with the system as taught by Walker it is very clear that in order for the system to verify the authenticity of the gift certificate, conventional telecommunications are used to link the verification process with a credit card provider such that the sixteen digit numeric value can be checked for association with the relevant credit card and thereby determine the authenticity of the gift certificate (see column 5, lines 39 to 50).

The system of the presently claimed invention does not require any communication with any particular credit card provider to validate the voucher, as the voucher is not associated with any particular credit card account. Rather, the presently claimed invention uses an alphanumeric value unique to each voucher, the value being arranged to verify the authenticity of the voucher and record its redemption. The applicant submits that in the presently claimed invention, the system operates quite differently to the system taught by Walker, which requires a link to a credit card issuer and thereby teaches a completely different form of validating a gift certificate through the use of different validation channels. Indeed, the system of Walker is inherently unreliable, as it exposes the credit card number of a user to third parties, such as any person who receives or

handles the gift certificate. As such, Walker inherently creates further security risks for the user. In contrast, the present invention is directed to a different system which is concerned with maintaining the security and privacy of the user. This is achieved, in part, through the use of a randomly generated, non-sequential, alphanumeric token. As such, the presently claimed invention is novel and non-obvious when compared to Walker.

Druckenmiller et al is directed to an opt-in system for verifying subscriptions to information distribution services. The document specifically teaches a system whereby a user can subscribe to a number of different electronic news subscriptions. In order to validate whether the subscription is authentic (and thereby reduce "SPAM" or unsolicited mail to non-subscribers), the subscription service generates a token which is communicated to a subscriber. If the subscriber responds with the generated token, the subscriber is deemed as having verified his or her initial subscription. This would then indicate the subscriber has given consent for the subscription to proceed and thereby the system will not be put into a position of sending unsolicited mail to any individual persons.

The applicants submit to the Examiner that the concept of using a token for verification is disclosed at column 4, lines 57 to 67 which discloses the use of a token uniquely associated with an address that has been generated. The applicant notes that the token used by Druckenmiller is merely used to identify the consent of a subscriber, not for the purpose of verifying the security of a transaction. The system as provided by Druckenmiller is far from secure or suitable for monetary or asset transactions. This is very clearly indicated by Druckenmiller at column 4, line 62, which indicates that the token can be generated sequentially, to thereby make the token highly predictable. A person skilled in the art is directed by Druckenmiller to utilize a sequential token, which clearly leads to a non-secure system which allows the token to be easily guessed or otherwise predicted. While this is not a problem in a subscription system where the user is not participating in any monetary transaction, rather a problem arises where sequential numbers (tokens) are utilized to identify and verify stored value instruments, such as gift certificates. Although Druckenmiller also mentions the use of a

randomly generated token, the system as disclosed by the document does not make use of this random token for security reasons.

Accordingly it is submitted by the applicant that Druckenmiller, at best, can minimize the chance of duplication in subscriptions rather than provide any real secure validation system that is provided by the presently claimed invention.

The Examiner is respectfully directed to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) which states the decision of obviousness is a question of law based on underlying factual enquiries. It is submitted to the Examiner, that when resolving the *Graham* factual enquiries in relation to the presently claimed invention, it would not be reasonable for a person skilled in the art to have found the presently claimed invention obvious in light of prior art as cited by the Examiner.

Firstly, the combination of the two documents cannot disclose the presently claimed invention. Walker et al teaches a system which utilizes the credit card system or an existing credit card provider or issuer to participate in the validation process of any particular gift certificate. Under these circumstances, as is already clearly disclosed by Walker, the method of validation is already significantly different from that of what is already claimed since the validation process involves an external party. If such a system was to be combined with the technologies of Druckenmiller which utilizes a sequential or random token, it would merely direct a person skilled in the art to a completely different system which utilizes both a validation process available through an existing credit card issuer combined with a subscription service which (presumably) would allow a user to "verify" the authenticity of a purchase of the gift certificate. It is not clear how the system of Walker could be modified with the teachings of Druckenmiller to arrive at the presently claimed invention. In any event, any combination would not be directed to the current system as claimed, as the validation process is significantly different and departs from those of both Walker and Druckenmiller.

Given the difference in operation between the gift certificate system of Walker and the electronic news subscription service of Druckenmiller, it would be unreasonable for a

person skilled in the art to have combined the two documents since the two documents are directed to completely different art. The mere fact that both systems are implemented on computing systems does not make them fall into the same category of art. Particularly, Druckenmiller is directed to a newsletter subscription service which is different in operation and design to any goods or services voucher creation and redemption system.

The Examiner will appreciate that in e-commerce systems, particularly where online monetary transactions are taking place, the validation process must be stringent. In other words, the design of the validation process is of utmost importance, in order to ensure or minimize fraudulent misrepresentations. The subscription service as disclosed by Druckenmiller, in contrast, is a non-monetary subscription service and the system disclosed therein is used as merely a means to ameliorate annoyance to an individual user who may not have requested a specific subscription. Therefore, a person skilled in the art is unlikely and could not be reasonably expected to look and combine art in the area of subscription services when seeking to create a system that requires a high level of security. As such, it would be unreasonable for a person skilled in the art to combine Walker with Druckenmiller.

It follows that a person skilled in the art, having recognized the differences in technology between the two different documents, would not have identified that any results combined would have been predictable in arriving at the claimed invention.

Finally, the Applicant submits to the Examiner that given the differences between the two documents and in particular to Walker teaching a different system of validation, it would not be possible to merely combine the two documents to come to the claimed invention. Rather there would be a significant amount of re-engineering required, including the restructuring of the validation process in Walker. It would be unreasonable to expect a person skilled in the art to be able to make these changes without any significant inventive input between the two systems as taught by Walker and Druckenmiller to arrive at the presently claimed invention.

In light of these submissions, the applicant respectfully requests the Examiner to reconsider the facts of the present matter with the directions as stated in *Graham v. John Deere Co.*

While the Examiner is able to cite Druckenmiller as a prior art document, the applicants submit that the earliest priority date of the present invention predates the publication of Druckenmiller and, in actual fact, predates the publication date of a majority of family members belonging to Walker. Although, this does not change the prior art base in the United States, it is submitted to the Examiner that the present invention teaches a new and inventive method of validating a goods and services voucher which offers an alternative to similar systems of the time. In light of these submissions, we respectfully ask the Examiner to withdraw the present objections relating to obviousness.

Claims 44-73 and 76-78 are rejected under 35 U.S.C. 103 as being unpatentable over Walker et al. and Druckenmiller et al. and further in view of Manasse (WO 97/03423), Scroggie et al. (U.S. Patent No. 6014634) or Jacoves et al. (U.S. Patent No. 6741968) or Fortenberry et al. (WO 99/30256). Applicant respectfully submits that no combination of these references cures the deficiencies of Walker and Druckenmiller described above with regard to the independent claims. Since no combination of the references teaches or suggest each element of independent claims 43, 74 and 75, applicant respectfully submits that the rejections of dependent claims 44-73 and 76-78 under 35 U.S.C. 103 are also improper and should be withdrawn. Reconsideration is respectfully requested.

CONCLUSION

If any points remain an issue which the Examiner feels may be best resolved through a telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. The Examiner is invited and encouraged to telephone the undersigned with any concerns in furtherance of the prosecution of the present application.

Please charge any deficiency as well as any other fee(s) which may become due at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-2896.

Respectfully submitted,

May 5, 2008

Dated:

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